

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

126726-1/YOD/FAR (GERD:0778)

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on July 21, 2008Signature /Floron C. Faries/Typed or printed name Floron C. Faries

Application Number

10/064,665

Filed

August 5, 2002

First Named Inventor

John W. Carbone

Art Unit

3627

Examiner

Sheikh, Asfand M.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

/Floron C. Faries/☐

assignee of record of the entire interest.

Signature

Floron C. Faries

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Typed or printed name

☒attorney or agent of record. 59,991281-970-4545

Registration number

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attorney or agent acting under 37 CFR 1.34.

July 21, 2008

Registration number if acting under 37 CFR 1.34 _____

Date

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Submit multiple forms if more than one signature is required, see below*.

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*Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	§	
John W. Carbone et al.	§	Group Art Unit: 3627
	§	
Serial No.: 10/064,665	§	Confirmation No.: 5321
	§	
Filed: August 5, 2002	§	Examiner: Sheikh, Asfand M.
	§	
For: System and Method for Providing	§	Atty. Docket: 126726-1/YOD/FAR
Asset Management and Tracking	§	GERD:0778
Capabilities	§	

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July 21, 2008

Date

/Florin C. Faries/

Florin C. Faries

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In light of the following remarks, Appellant respectfully requests review of the Final Rejection in the above-identified application. No amendments are being filed with this Request. This Request is being filed with a Notice of Appeal. In the Final Office Action, the Examiner rejected claims 1-50. Claims 1 and 26 are independent.

Legal Error of Claim Rejections under 35 U.S.C. § 103(a)

The Examiner rejected independent claims 1 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Marsh (U.S. Publication No. 2003/0023517, hereinafter “Marsh”) in view of Maltseff (U.S. Publication No. 2002/00997282, hereinafter “Maltseff.”

Legal Precedent

The burden of establishing a *prima facie* case of obviousness under 35 U.S.C. § 103 falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). To establish a *prima facie* case of obviousness, the Examiner must show that the combination includes *all* of the claimed elements, *and* also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

Deficiencies of the Rejection

The Examiner rejected the only two independent claims 1 and 26 based on the combination of Marsh and Maltseff. Applicants initially stress that the cited combination does not teach or suggest all of the elements of claims 1 and 26. For example, the central tax information database 18 of Maltseff is *not* an asset management system, as apparently alleged by the Examiner. *See* Final Office Action, page 5.

Second, contrary to legal precedent, Applicants believe there is no appropriate reason, much less feasible, to modify Marsh to separate the Marsh components, as apparently proposed by the Examiner. Indeed, the “transmission device” of Marsh, which is referred to in one single passage in paragraph 21 of the reference, is said to be “advantageously connected” to the computing device, apparently within the field control device 110. No other description or qualification is made in Marsh of the structures or functions of the “transmission device” and the “computing device”. It would appear from Marsh that the two devices are provided together and are, at the very least, inseparable. *See, e.g.*, Marsh, paragraph 21.

To be sure, the Examiner has not explained the feasibility of such a modification of Marsh. The Examiner relied on the secondary reference (Maltseff) to teach a field control device operatively connected to an asset management system and further the remote client computer system contains at least one interrogation device that is separate from the remote client computer. See Final Office Action, page 5. However, again, the Examiner provide no reasonable explanation or appropriate reason to modify Marsh. The Supreme Court has recently stated that the obviousness analysis should be explicit. See *KSR Int'l Co. v. Teleflex, Inc.*, 82 U.S.P.Q.2d 1385 (U.S. 2007) (“[R]ejections based on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”) (quoting *In re Kahn*, 441 F.3d 977,988 (Fed. Cir. 2006)). In the present rejection, the Examiner has failed to meet this requirement of the obviousness analysis, and therefore has not established a *prima facie* case of obviousness. Appellants strongly believe that that there is not an appropriate reason to modify Marsh in such a way as to read on independent claims 1 and 26. In view of the foregoing, Marsh cannot anticipate claims 1 and 26, or their dependent claims.

Request Review of Final Rejections

For the above reasons, Appellants respectfully request reviews of the Final Rejections prior to filing of an Appeal Brief in the present application.

Respectfully submitted,

Date: July 21, 2008

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